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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/866,789	05/30/2001	Keiju Kuboki	35.C15385	5081

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EXAMINER

BEATTY, ROBERT B

ART UNIT PAPER NUMBER

2852

DATE MAILED: 12/11/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/866,789

Applicant(s)

KUBOKI, KEIJU

Examiner

Robert Beatty

Art Unit

2852

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 September 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-66 is/are pending in the application.
- 4a) Of the above claim(s) 18-57, 62-66 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 58-61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

1. Newly submitted claims 18-57,62-66 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Claims 18-34,62-63 are directed to an image forming apparatus having a trial copy mode with controller for prohibiting/allowing the execution of the trial copy mode.

Claims 35-51,64-65 are directed to an image forming apparatus having a trial copy mode having first and second displays for inputting data or notifying the operator.

Claims 52-57,66 are directed to an image forming apparatus having a trial copy mode and which reads image data stored in a memory using a box function.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 18-57,62-66 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

2. Claims 1-17, 58-61 are rejected under 35 U.S.C. 102(a) as being anticipated by Endo et al.

Endo et al. teach an image forming apparatus comprising an image input means 106 for scanning an original document to produce digital image data, a storage means 501, <sup>(Fig. 2)</sup> 510 for storing the digitized image data and image forming means 118 for reading the image data and forming an image onto a paper sheet. Various settings can be activated for producing a desired output such as density, duplex mode, magnification, number of sets to be produced, etc. A sample set of sheets can be formed by activating a sample set command key 209. When the sample set key is activated the image forming apparatus switches to a mode wherein a set of copies are made and output to a sorter. Thereafter the image forming apparatus will enter a waiting mode which waits for an operator to either accept the output copies or change one of the settings <sup>(col. 12, line 46 - col. 13, line 32)</sup> (see col. 13, lines 1-20). A copy set numeral can be changed according to whether the sample copy set is accepted or not. If it is accepted, then the remaining desired sets will be the one minus the originally input desired sets. If it is not accepted, then the remaining sets will be the original input desired sets. See col. 25, lines 45-63.

3. Applicant's arguments with respect to claim 1-66 have been considered but are moot in view of the new ground(s) of rejection.

Applicant argues that Endo et al. does not teach setting the numeric data information (number of copies to be printed) in accordance with a state of reset of the image forming mode. However, Endo et al. is believed to teach (see Fig.21, and col.25, line.45 – col.26, line 61) that if a setting condition key is changed (S906, S914) , the image forming mode will be set to another set of conditions (S915, S905) which will be detected (S908) and the number of copies to be output will be changed accordingly (S909,S910). Thus, the examiner believes that the changing of a setting condition in the image forming apparatus would correspond to applicant's "reset of the image forming mode".

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will

the statutory period for reply expire later than SIX MONTHS from the date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Beatty whose telephone number is 703-308-1372. The examiner can normally be reached on M-F from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Arthur Grimley, can be reached on (703) 308-1373. The fax phone number for the organization where this application or proceeding is assigned is 703-308-3431.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1782.

A handwritten signature in black ink, appearing to read 'Robert Beatty', with a long horizontal line extending from the end of the signature.

Robert Beatty  
Primary Examiner  
Art Unit 2852

December 10, 2002